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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,293	12/03/2003	Guy Brouillette	CA920020078US1	1292
24241	7590	09/28/2005	EXAMINER	
IBM MICROELECTRONICS INTELLECTUAL PROPERTY LAW 1000 RIVER STREET 972 E ESSEX JUNCTION, VT 05452			EDMONDSON, LYNNE RENEE	
			ART UNIT	PAPER NUMBER
			1725	
DATE MAILED: 09/28/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/707,293

Applicant(s)

BROUILLETTE ET AL.

Examiner

Lynne Edmondson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8-11, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) 4-7 and 12-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-3, 8 and 9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10-12, 15, 19-21, 24, 33, 37 and 38 of U.S. Patent No. 6003757. Although the conflicting claims are not identical, they are not patentably distinct from each other because both teach a method and apparatus for transferring solder bumps from a mold to pads of a substrate by locating a substrate on a base, positioning a mold having a plurality of solder elements such that the solder contacts a corresponding pad, pressing a plate on the mold, heating the solder elements and removing the plate while the solder is molten. Solder bumps are subsequently solidified. The apparatus comprises a reflow heating device and a mold with multiple cavities. However the '757 claims are slightly narrower. The back plate is described as a lid and the plurality of compressing members are described as pins in the '757 claims.

It would have been obvious to one of ordinary skill in the art at the time of the invention that although the parts have different names, the structure and function is the same.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 9-11 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Covell, II et al. (USPN 5718367).

Covell teaches a method and apparatus for transferring solder bumps from a mold to pads of a substrate by locating a substrate on a base, positioning a mold having a plurality of solder elements such that the solder contacts a corresponding pad, pressing a plate on the mold, heating the solder elements and removing the plate while the solder is molten. Solder bumps are subsequently solidified. The apparatus comprises a reflow heating device (oven) and a mold with multiple cavities and multiple pressing devices (figure 4, col 7 line 43 – col 8 line 44).

5. Claims 1-3, 9-11 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Brouillette et al.(USPN 6394334 B1).

Brouillette teaches a method and apparatus for transferring solder bumps from a mold to pads of a substrate by locating a substrate on a base, positioning a mold having a plurality of solder elements such that the solder contacts a corresponding pad, pressing a plate on the mold, heating the solder elements and removing the plate while the solder is molten. Solder bumps are subsequently solidified. The apparatus comprises a reflow heating device (oven) and a mold with multiple cavities (col 9 line 30 – col 10 line 17).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

6. Claims 1-3, 8-11, 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Beaumont et al.(USPN 6003757).

Beaumont teaches a method and apparatus for transferring solder bumps from a mold to pads of a substrate by locating a substrate on a base, positioning a mold having a plurality of solder elements such that the solder contacts a corresponding pad,

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pressing a plate on the mold, heating the solder elements and removing the plate while the solder is molten. Solder bumps are subsequently solidified (col 5 line 48 – col 6 line 48 and col 7 lines 1-25). The apparatus comprises a reflow heating device (oven) and a mold with multiple cavities and multiple pressing devices (figures 1, 3A, 3B).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Allowable Subject Matter

7. Claims 4-7 and 12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bolde et al. (USPN 61535505), Trabucco (USPN 5381848),

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Gruber et al. (USPN 6708872 B2), Fisher, Jr. (USPN 4412642) and Ratz (DE 3623031 A).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynne Edmondson whose telephone number is (571) 272-1172. The examiner can normally be reached on Monday through Thursday from 6:30 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lynne Edmondson
Primary Examiner
Art Unit 1725

LLE
2/23/05

LRE